

Application No.: 10/612,454

Docket No.: 60680-1739

REMARKS

Applicants have carefully reviewed the Office Action mailed January 12, 2005, and thank Examiner Jacyna for the detailed review of the pending claims. Claims 1 and 6 have been amended. Claims 2 and 7 have been cancelled. Accordingly, Claims 1, 3-6, 8, and 9 remain pending in this application. Applicants respectfully request reconsideration of the present application in view of the following remarks.

Claim Rejections – 35 U.S.C. § 102

Claims 1-3, 5-7 and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,609,700 to *Leimer* (hereinafter "*Leimer*"). Applicants respectfully traverse the rejection.

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the ... claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

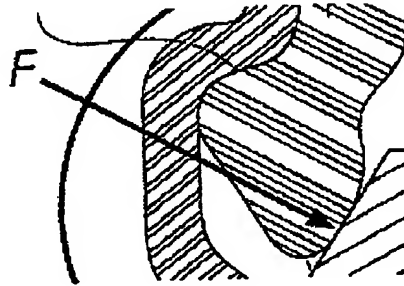
As amended, claims 1 and 6 provide that "the step exerts a compression force substantially perpendicular to a surface of the chamfer, F, against the second sealing lip to seal the second sealing lip against the chamber of the valve guide." The sealing lip of the present invention depends at an angle from the sealing element "for sealing a chamfer of a valve guide." See *claims 1 and 6*. Further, the step is configured to generate a sealing force F that is substantially perpendicular to the chamfer of the valve guide.

In contrast, the *Leimer* reference teaches a sealing lip 19 "depend[ing] vertically downwardly against a top of the valve guide." See *col. 3, lines 33-35*. Indeed, *Leimer* explicitly states that the sealing lip depends vertically downwardly against a top of the valve guide. However, in the present invention, the sealing lip of claims 1 and 6 include a

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compressive force “substantially perpendicular to a surface of the chamfer” of the valve guide.
See illustration below from Fig. 3 of the present invention.



Accordingly, in *Leimer* no substantially perpendicular force is present against the chamfer. The seal depends vertically downwardly against the top of the valve guide. In this way, the seal cannot develop a substantially perpendicular sealing force against the chamfer of the valve guide. This is unlike the present invention, as defined by amended claims 1 and 6 where the compressive force of the sealing lip is substantially perpendicular to a surface of the chamfer.

Therefore, because *Leimer* does not include a sealing lip for the chamfer of a valve guide that has a compressive force substantially perpendicular to a surface of the chamfer, *Leimer* does not disclose the claimed invention. Thus independent claims 1 and 6 are in condition for allowance. Similarly, for at least the same reasons as claims 1 and 6, dependent claims 2-3, 5, 7, and 9 are in condition for allowance.

Claim Rejections – 35 U.S.C. § 103

Claims 4 and 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,609,700 to *Leimer* in view of U.S. Patent No. 6,209,504 to *Hegemier et al.* (hereinafter *Hegemier*). Applicants respectfully traverse the rejection. Applicants note that the remarks presented above with respect to the §102(e) rejection are equally applicable here.

A *prima facie* case of obviousness requires, *inter alia*, that the applied references teach or suggest all of the claim limitations. See MPEP §2143; *In re Vacek*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *In re Royka*, 490 F.2d 981, 180 USPQ 560, 562 (CCPA

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1972). Applicants respectfully traverse the 103(a) rejections because the references cited in the Office Action do not teach every element of the claims, and the rejections do not satisfy the standard set forth by the Federal Circuit in *In re Thrift*, 298 F.3d 1357; 63 USPQ2d 2002 (Fed. Cir. 2002), which prohibits the rejections of claims based on “very general and broad conclusions” when “cited references do not support each limitation” in a claim.

A *prima facie* case of obviousness also requires that there be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. See MPEP §2143; *In re Linter*, 458 F.2d 1013, 173 USPQ 560, 562 (CCPA 1972). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Moreover, the fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

The Examiner has applied *Leimer* to teach a valve stem seal, and is using *Hegemier* to teach a “seal bonded to the retainer for the purpose of ensuring that the seal remains in place on the valve stem.” See *Office Action* page 2, paragraph 4. In order to properly combine these references, the Examiner must provide motivation for one skilled in the art to make the proposed modification.

In re Fritch provides that “the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art,” and that “the Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” 23 USPQ2d. 1780, at 1783. In focusing efforts to meet this burden, the Federal Circuit concluded that “under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.” *Id.* (Emphasis in original) The Examiner is kindly requested to provide a motivation to make the proposed combination.

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In the present case, *Hegemier* teaches that the bonding is used "to provide a tight seal." See Col 3, Lines 57-60 and Col 4, Lines 18-20. On the other hand, the Office Action suggests that the bonding is "ensuring that the valve seal remains in place on the valve stem," which is not a sealing purpose but a locating and/or retaining purpose. See Office Action page 2, paragraph 4. On the contrary, *Hegemier* suggests a mechanical configuration for locating the seal, wherein "the valve stem seal retainer 28 includes ... an upper portion for fixing the valve stem seal in place." See Col 3, Lines 46-50. Thus, *Hegemier* provides motivation to retain the valve stem seal by configuring the retainer to mechanically hold the seal in place. Additionally, *Hegemier* teaches that the bonding is used "to provide a tight seal" rather than to hold the seal in place. See Col. 4, Lines 16-20.

Neither reference holds a suggestion or motivation to combine. Thus, it is unclear to Applicants how *Leimer* and *Hegemier* can be combined (or viewed in light of each other) to make the valve stem seal assembly of claims 4 and 8. Furthermore, the teachings of *Hegemier* appear to encourage one to use the structure of the retainer to hold the seal in place, rather than bonding. In this regard, *Hegemier* directly teaches away from the Examiner's suggestion that the bonding is intended to retain the seal. Therefore, there is no motivation to make a combination, and neither reference "suggests the desirability of the combination." See above, *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

CONCLUSION

In view of the above amendment and remarks, the pending application is in condition for allowance. If, however, there are any outstanding issues that can be resolved by telephone conference, the Examiner is earnestly encouraged to telephone the undersigned representative.

It is believed that any additional fees due with respect to this paper have already been identified in any transmittal accompanying this paper. However, if any additional fees are required in connection with the filing of this paper that are not identified in any accompanying transmittal, permission is given to charge our Deposit Account No. 18-0013, under Order No. 60680-1739 from which the undersigned is authorized to draw.

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